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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,006	12/12/2000	Patrick L. Horner	0788.0005	3385
23476	7590	11/25/2003	EXAMINER	
EMERSON & SKERIOTIS ONE CASCADE PLAZA FOURTEENTH FLOOR AKRON, OH 44308			NGUYEN, PHUONGCHI T	
			ART UNIT	PAPER NUMBER
			2833	

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/735,006	HORNER, PATRICK L.
	Examiner Phuongchi T Nguyen	Art Unit 2833 44

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 September 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-9 and 15-21 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 1 and 6-9 is/are allowed.

6) Claim(s) 2-5 and 15-21 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

15) Notice of References Cited (PTO-892)      18) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)      19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .      20) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Applicant's amendment of September 05, 2003 is acknowledged. It is noted that claims 2, 4, 6 are amended. New claims 15-21 are added.
2. The amendment filed on September 05, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure is as follows: the limitation "the female end extends ... downwardly from the first end" in claim 15, "the female end is made of a flexible material" in claim 19, and "the female end extending downwardly from the base" in claim 21 are not mentioned in the original specification, claims or shown in the drawings. Applicant is required to cancel the new matter in the reply to this Office Action.

*Claim Objections*

3. Claim 4, line 3, is objected to because of the following informalities: it is unclear "an associated vacant cavity" of claim 4, line 3 is the same or different from "an associated vacant cavity" of claim 2, line 5. If they are the same, it should be changed into -- the associated vacant cavity --; if they are different, the order of the cavity should be labeled. Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 2-3 and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by DeMello (US5997320).

In regard to claim 2, DeMello discloses a dummy plug (12) for use with an associated wiring harness having a first length (L1), a latch beam, and a latch arm, the dummy plug (12) comprising a first end (74); a female end (76) the female end (76) being capable of being inserted into an associated vacant cavity (opening where 48 located); and a second length (L2), the second length (L2) being substantially the same as the associated first length (L1) (see Attachment 1).

In regard to claim 3, DeMello discloses the dummy plug (12) wherein the dummy plug (12) further comprises a head (A); a stem (B) (see Attachment 1).

In regard to claim 15, DeMello discloses the female end (76) extends outwardly from the first end (74) (attachment 1).

In regard to claim 16, DeMello discloses the female end (76) is fixed attached to the stem (B) (attachment 1).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-5 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeMello (US5997320).

In regard to claims 4 and 17, DeMello discloses the dummy plug (12) wherein the stem (B) has a second width (W2), the female end (76) has a third width (W3), the third width (W3) being greater than the second width (W2), wherein the head (A) and the stem (B) are capable of

being inserted into an associated cavity (37) (see Attachment 1). It has been held that the recitation that the head and the stem "capable of" performing a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. In this instance, whether the cavity is vacant or not, the head and the stem of the dummy plug would perform the same function.

In regard to claims 5 and 18, DeMello discloses the dummy plug (12) wherein the first end (74) has a first width (W1), the first width (W1) being greater than the third width (W3) (see Attachment 1).

***Allowable Subject Matter***

8. Claims 1 and 6-9 are allowed.

***Response to Arguments***

9. Applicant's arguments of "the part in DeMello ... has labeled the female end is clearly not capable of being inserted into anything" is not deemed persuasive. It clearly shows in the attachment 1 that the female end 76 is capable to insert into the vacant cavity where 48 located. it has been held that the recitation that the head and the stem "capable of" performing a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PhuongChi Nguyen whose telephone number is (703) 305-0729. The examiner can normally be reached on Monday through Thursday from 8:AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Austin Bradley, can be reached on (703) 308-2319. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

November 17, 2003.

*P. Bradley*  
P. AUSTIN BRADLEY  
SUPERVISORY PATENT EXAMINER  
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